



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/743,324

12/23/2003

Eric Apps

012244-369099

5560

27155 7590 10/27/2006

MCCARTHY TETRAULT LLP
BOX 48, SUITE 4700,
66WELLINGTON STREET WEST
TORONTO, ON M5K 1E6
CANADA

EXAMINER

PONIKIEWSKI, TOMASZ

ART UNIT

PAPER NUMBER

2165

DATE MAILED: 10/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/743,324	Applicant(s) APPS ET AL.	
	Examiner Tomasz Ponikiewski	Art Unit 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-23,25-34 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-23,25-34 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment filed on August 17, 2006 is acknowledged. Claims 1-16, 24 and 35 have been canceled. Claim 36 has been added. Claims 17-23, 25-34 and 36 are therefore pending.
2. The amendment filed on August 17, 2006 corrected the objections and rejections under 112 2nd.
3. In light of newly found art a new non-final rejection is presented below.

Specification

4. The disclosure is objected to because there are various pages containing products missing trademark symbols. For example on page 10 "Windows" is missing the trademark symbol.

Claim Objections

5. Claims 17-21 23, 28-30, 32 and 34 are objected to because of the following informalities:

Claims 17 and 33 recite "ones" in lines 7 and 2 respectively. The recitation is vague, as it does not definitely point out to what it is referring. Appropriate correction is required.

Claims 18-21, 23, 28-30, 32 and 34 recite the limitation "at least one of". The limitation requires that only one of the elements be found for the reference to be true. Further if the applicant's intention is to claim Markush type claim then the claim should be written to include "selected from the group consisting of".

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 25, 33 and 34 are rejected under 35 U.S.C. 112, second paragraph; as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 25 and 33 both state how the second input is applied to the invention. However, claim 25 states that the user supplies the inputs while claim 33 states that reporting system provides the second inputs. It is unclear how both instances can be true.

Claim 34 recite, "to enable". Enabling does not mean that the step is being accomplished. It suggests a capability but not necessarily taking place. It should be amended to recite definite language i.e. "configured to" or "to".

Claim 34 makes use of "at least one of" statement. If the selection of at least one of is made to "user, it would make the claim unstatutory as it would be directed to human being.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 17-23, 25-34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkinson et al. (US 2002/0174182 A1) in view of Vishnubhotla (US 6,636,860 B2).

As per claim 17 Wilkinson et al. is directed to a data mining system for delivering presentations associated with data mining models, said data mining system comprising:

a) a repository to store said data mining models and said presentations (Wilkinson et al., paragraph 0032, second column, lines 4-5, wherein information associated with target could mean data models and presentations);

b) means for access, create, update, and import said data mining models, said presentations, and content and structure of said repository (Wilkinson et al., paragraph 0032, second column, lines 14-15, wherein "data mining models" could mean

Art Unit: 2165

"interaction motivation plan"; paragraph 0032, second column, lines 29-33; paragraph 0040, lines 5-10, wherein having fields could mean that they were specifically created);

c) means to select and prepare ones of said presentations for delivery to users; and, (Wilkinson et al., paragraph 0032, second column, lines 18-28)

d) means to access said data mining system by said users, to receiving first and second inputs from said users, and to deliver said presentations to said users (Wilkinson et al., paragraph 0045, lines 11-14).

Wilkinson et al. does not teach wherein said means to select and prepare includes an analytic decision engine system including model presentation services and scoring services modules.

Vishnubhotla does teach said means to select and prepare includes an analytic decision engine system including model presentation services and scoring services modules (Vishnubhotla, column 8, lines 25-29; column 8, lines 34-37; column 11, lines 55-56).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Wilkinson et al. with teachings of Vishnubhotla to include means to select and prepare includes an analytic decision engine system including model presentation services and scoring services modules because having choice of data mining models would lessen the need for specialized data mining expertise of end user (Vishnubhotla, column 2, lines 66-67; Vishnubhotla, column 3, lines 1-2).

Art Unit: 2165

As per claim 18 Wilkinson et al as modified is directed to said data mining models include at least one of simple and complex scores, static and dynamic scores, rules, rules sets, and rules systems, and composites and combinations of said scores, rules, rules sets, and rules systems (Wilkinson et al., paragraph 0024, lines 7-9; wherein the “logical rules” could encompass all recited limitations).

As per claim 19 Wilkinson et al as modified is directed to said presentations include defined sets of content including at least one of data mining model references, scores, rules, attributes, activity suggestions, to do lists, pop-up windows, HTML segments, and XML scripts (Wilkinson et al., paragraph 0033, lines 9-12 wherein “time” could mean an “attribute”).

As per claim 20 Wilkinson et al as modified is directed to said presentations include at least one of simple presentations, range based presentations, and complex presentations (Wilkinson et al., paragraph, 0022; paragraph 0023, lines 11-14; paragraph 0024, second column, lines 2-8).

As per claim 21 Wilkinson et al. as modified is directed to said repository is a database having at least one of a database schema and a database management system (Wilkinson et al., paragraph 0032, second column, lines 4-5).

As per claim 22 Wilkinson et al as modified is directed to said means to access, create, update, and import said data mining models, said presentations, and said content and structure of said repository includes a data mining console system (Wilkinson et al., paragraph 0032, second column, lines 14-15, wherein "data mining models" could mean "interaction motivation plan"; paragraph 0032, second column, lines 30-34; paragraph 0040, lines 5-10, wherein having fields could mean that they were specifically created).

As per claim 25 Wilkinson et al as modified is directed to said means to access said data mining system by said users, to receive first and second inputs from said users, and to deliver said presentations to said users includes a network (Wilkinson et al., paragraph 0032, second column lines 11-12, paragraph 0038, lines 8-10; paragraph 0038, lines 13-15; paragraph 0046, lines 2-9).

As per claim 26 Wilkinson et al as modified is directed said users include one or more data mining management consoles integrated with or connected over said network (Wilkinson et al., paragraph 0031, line 5; paragraph 0046, line 9).

As per claim 27 Wilkinson et al as modified is directed said users include one or more applications running on a computer, system, or other appliance integrated with or connected over said network (Wilkinson et al., figure 2B, number 238, 232; paragraph 0046).

As per claim 28 Wilkinson et al as modified is directed said users include one or more thin or thick clients in a client-server or browser-server environment integrated with or connected over a network (Wilkinson et al., paragraph 0046, line 9).

As per claim 29 Wilkinson et al as modified is directed to said first inputs include attributes provided by or associated with said users including at least one of an identity and a locator (Wilkinson et al., paragraph 0032, second column, lines 6-8; paragraph 0037, second column 10-11).

As per claim 30 Wilkinson et al as modified is directed to said second inputs include at least one of updates, edits, modifications, deletions, replacements, suspensions, changes, improvements, and optimizations of said data mining models and said presentations (Wilkinson et al., paragraph 0033, lines 14-21, wherein the "feedback" could mean "second input").

As per claim 31 Wilkinson et al as modified is directed to said data mining system includes one or more reporting systems (Wilkinson et al., paragraph 0021, page 3, lines 7-9).

As per claim 32 Wilkinson et al as modified is directed to said reporting systems include at least one of outcome monitoring systems and presentation usage monitoring systems (Wilkinson et al., paragraph 0021, page 3, lines 7-13).

As per claim 33 Wilkinson et al as modified is directed to said reporting systems provide ones of said second inputs (Wilkinson et al., paragraph 0021, page 3, lines 10-13; paragraph 0033, lines 14-21).

As per claim 34 Wilkinson et al as modified is directed to said data mining system includes at least one of servers, memory devices, processing units, input devices, output devices, display devices, and said users to store and process sequences of instructions and to enable communications with said users (Wilkinson et al., paragraph 0046).

As per claim 36 Wilkinson et al as modified is directed to wherein said network is an Internet network (Wilkinson et al., paragraph 0046, line 9).

As per claim 23 Wilkinson et al. does not teach step of creating said presentations and said data mining models is accomplished by means including text editor, scripting tool, web development tool, and HTML editor.

Vishnubhotla does teach step of creating said presentations and said data mining models is accomplished by means including text editor, scripting tool, web development

Art Unit: 2165

tool, and HTML editor (Vishnubhotla, column 19, lines 21-26; Vishnubhotla, column 19, pages 53-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Wilkinson et al. with teachings of Vishnubhotla to include step of creating said presentations and said data mining models is accomplished by means including text editor, scripting tool, web development tool, and HTML editor because creating needs some sort of editor or tool.

Response to Amendment

10. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tomasz Ponikiewski whose telephone number is (571)272-1721. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (571)272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2165

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tomasz Ponikiewski
October 24, 2006.

Apr Mojiz
Apr Mojiz
Primary Examiner
TC 2100